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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 20070205

Application Number: 09/112,131
Filing date: July 8, 1998
Appellants: Walker et al.

MAILED

Michael Downs (Reg. No. 50,252)
For Appellants

FEB 07 2007

EXAMINER'S ANSWER

GROUP 3600

This is in response to appellant's brief on appeal filed on 11/20/2006.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

There is none related appeal and interference which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments contained in the brief is correct.

(5) *Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is correct.

(6) *Ground of Rejection*

The appellant's statement of the Ground of Rejection in the brief is correct.

(7) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

- USPTO's Manual of Patent Examining Procedure (MPEP) Rev. 14, Nov. 1992.

(9) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims. The ground(s) for rejection (for pending claims 177-189) are provided here for the convenience of both Appellants and the Board of Patent Appeals.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

A. Claim 177 is rejected under 35 U.S.C. § 102(b) as being anticipate by USPTO's MPEP Rev. 14, Nov. 1992.

Claim 177 is directed to a computer-implemented expert matching method for managing communications between an expert and an end user (i.e., a primary examiner's function at USPTO, and an applicant), comprising:

- receiving a first expert qualification (i.e., receiving a message about the authority of a primary examiner) corresponding to a first expert (i.e., USPTO's TC 3600 group director “assigns” an examiner to examine a patent application, said examiner name and his art unit would be given to the applicant for communications relating to examining processes (assigning an examiner to an application) – this examiner name would be communicated to the applicant, and recording to USPTO database/group director as a point-of-contact POC – i.e., in all Office Actions of this application (see USPTO's MPEP Rev. 14, published on Nov. 1992, chapter 700, page 700-5 (section 705.01(e)) – note that this examiner's SPE could substitute/perform above functions of a TC 3600 group director;
- selecting a second expert (i.e., selecting an SPE) that has a second expert qualification (i.e., the message about the authority of an SPE in the same Art Unit –

having authority to approve that primary examiner's action), the second expert qualification being higher than the first expert qualification (i.e., an SPE is considered as a senior examiner in this primary examiner's Art Unit for consultation on a specific subject matter e.g., a current technology for MagLev train – a very high speed train using magnetic field; or a patent application on business method using a smart-card technology; a senior/primary examiner that specializes in another art unit dealing with smart-card technology is consulted by email via computer) is also selected to review and approve that examiner's qualification/decision – i.e., the SPE must approve any correction from issued patent examining by that examiner) (see USPTO's MPEP Rev. 14, published on Nov. 1992, chapter 700, page 700-5 (section 705.01(e)) (a group director can transfer an examiner to a different art unit for a better "fit" (an SPE can make his own request for this transfer), that examiner personal record is sent to a new supervisor (with/without electronically means: emails, telephone, word-processing) of said different art unit for reviewing qualifications);

- transmitting the first expert qualification (i.e., a primary examiner) to the second expert (i.e., an SPE)(e.g., via computerized telephone, or internal "transmitting" via email (i.e., using any computer communication means) said examiner's qualification to that group director/supervisor for a best match between examiner(s) to examining a specific customer's application), (see USPTO's MPEP Rev. 13, published on Nov. 1989, chapter 1005, page 1000-9, this section inherently requires an examiner having Full/Partial-Signatory-Authority to sign a certain Office Action after he has been authorized to do so (after examiner's qualification is reviewed by a group director and/or an SPE)); and

- receiving a signal from the second expert (i.e., an SPE) that indicates approval of the first expert qualification (i.e., The primary examiner's expertise allows him to interpreted correctly a prior art that agreeing by an SPE as a clear anticipation of that prior art; that SPE gives a signal to concur that qualification/decision; or a supervisor "assigns" a specific patent application to said examiner after reviewing and approval of said examiner's qualification for a claimed specific subject matter – or a group director gives a "Full-Signatory-Authority" to an examiner for decision-makings through a whole process of examining a patent application: a Full-Sig. examiner can allow a patent application; for example, (see USPTO's MPEP Rev. 13, published on Nov. 1989, chapter 1005, page 1000-9).

The above claimed limitations are taught in USPTO MPEP Rev. 14, published on Nov. 1992, chapter 700, pp. 700-5 (section 705.01(e)) to 700-8, and USPTO's MPEP Rev. 13, published on Nov. 1989, chapter 1005, page 1000-9) – note that a step performed via computer is enough to claim that method is "a computer-implemented method": for instance, a supervisor (SPE) uses email to show his approval of that primary's decision.

B. Claims 178-179 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPTO's MPEP Rev. 14, published on Nov. 1992.

A1. Claim 178 is directed to a computer implemented expert matching method for managing communications between an expert and an end user, comprising all limitations of claim 177 (analyzed above), and:

- incorporating identity data of the second expert into a key of the first expert.
- The rationales and reference for rejection of claim 177 are incorporated.

USPTO's MPEP teaches that a group director or a supervisor or a primary examiner in a specific art unit (as a second expert) and a patent examiner (as a first expert) are belongs to the same technology center (i.e., the names of a group director/supervisor and his examiners has been required to put together as alternative point-of-contacts in a USPTO Office Action (see USPTO's MPEP Rev. 13, Nov. 1989, chapter 1002.02, page 1000-3 for teaching that identity data (names, art unit, Technology Center) of a group director and his examiner appears on an Official Document at USPTO; if a consultation about a specific topic was happened, said primary examiner's name has been included in the record for search consultation).

A2. Claims 179, and 185 are directed to a computer implemented expert matching method for managing communications between an expert and an end user, comprising all limitations of claim 178, and:

- submitting the first expert qualification for review by a set of experts/(or a second expert) that having a qualification that is higher than the first expert qualification (e.g., personal record of an examiner has been distributed to different supervisor(s) for a better match);
- receiving a signal from the set of experts/(or from a second expert) that indicates approval of the first expert qualification (e.g., a tel. call from a supervisor to a director);
- receiving an end user request from an end user; selecting the first expert based on the end user request (e.g., a request from applicant to exam a case under "special status" because said inventor is 75 year-old; that case has been assigned to a specific examiner);
- transmitting end-user's request to the first expert; receiving an expert answer responsive to the end user request, the expert answer containing information about the

second expert (e.g., communication between an examiner and an applicant for a patent application having a second expert's inputs/opinion); and

- transmitting the expert answer to the end user (e.g., mailing an Office Action from USPTO to an applicant).

The above claimed limitations also can be done manually.

C. Claim 180-189 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPTO's MPEP Rev. 14, published on Nov. 1992.

A1. As to claims 180-181, 183, 186-187, and 189: The examiner respectfully submits that it is old and well-known that an applicant for a US Patent must make payment to USPTO to begin an examination process – that means a guaranteeing payment to the USPTO - comprises requiring the customer to prepay before considering a service (by checking/verifying an account for validity - for a good balance before charging a fee)..

It would have been obvious to one of ordinary skill in the art at the time of invention to appreciate an old and well-known fact that USPTO financial department could check a customer account to confirm that “everything is fine/conformed” when charging an applicant’s account as required in USPTO’s MPEP before rendering an examination service.

A2. As to claims 182, and 188: The examiner respectfully submits that a duty of Office of Finance at USPTO is checking a credit card account (checking an applicant’s deposit account for a fee paid, or for a good balance).

A3. Claim 184: The examiner respectfully submits that it is old and well known about establishing a price for the expert answer corresponding to the end user request; and if

credit available on the credit card account is less than a required fee, requesting that the end user provide a credit card number of another credit card account (USPTO's practice).

A4. Claim 185: A computer implemented expert matching method for managing communications between an expert and an end user, comprising:

- receiving a first expert qualification corresponding to a first expert;
- selecting a second expert that has a second expert qualification, the second expert qualification being higher than the first expert qualification;
- transmitting the first expert qualification to the second expert;
- receiving a signal from the second expert that indicates approval of the first expert qualification;
- receiving an end user request from an end user; selecting the first expert based on the end user request; transmitting at least a portion of the end user request to the first expert;
- receiving the expert answer responsive to the end user request; the expert answer containing information about the second expert; and
- transmitting the expert answer to the end user.

A5. Claim 186: The examiner respectfully submits that it is old and well known about guaranteeing payment to the first expert (a paycheck every 2 weeks).

A6. Claim 187: The examiner respectfully submits that it is old and well known about requiring the end user to prepay (an inventor must prepay to exam his invention for USPTO annual budget).

A7. Claim 189: The examiner respectfully submits that it is old and well-known about checking a credit card account is performed before said transmitting at least a

portion of the end user request to the first expert (USPTO checking a deposit account before ordering an examiner to examine an invention).

(10) Response to Argument:

Since the pending claims are very broad, they read on the cited references for a hierarchy management in an agency such as USPTO (the examiner only cites a very familiar example; there are many more of these instances where computer-implemented communication are used to run a company – a computer-implemented step is a step that use a computerized equipment, such as a telephone, email, word-processors .etc.). The cited reference clearly suggest what to do, who take what responsibility, where does it happen – MPEP does not explicitly disclose who to perform listed responsibilities; however, job functions described in MPEP already defines the functions for each role within USPTO. The examiner disagrees that the pending claims are original idea(s) of the applicants – what the applicants claim are not new; the claimed concept is merely a second opinion request before making a decision (for a personal interest, or for a company's operation).

The examiner presents a very clear evidence of USPTO's operation and its personnel's functionalities from a published MPEP document; however, the appellants still argue that the examiner has not provided a proper legal basis for rejecting any claim – the examiner strongly disagrees.

Appellants argue that "...nothing in **USPTO procedure** entails the claimed steps of "receiving a first expert "qualification" corresponding to the first expert", nor "transmitting the first expert "qualification" to a second expert", nor "receiving a "signal" from a second expert that indicates approval of the first expert "qualification", the

examiner submits that these kinds of actions have been widely used in many areas
(USPTO might not expressly say that limitation exactly as claimed languages, neither published those detailed ideas how to solve a problem, but in its telephone directory, or organization chart, clearly showing a hierarchical order that reflecting above limitations for a smooth operation, i.e., art unit 705, sub-class 26 defined the listed examiners having “e-shopping” knowledge/skills to examining this kind of specific cases, the supervisor of this art unit (A.U. 3625) has a senior level of patent examining functions and familiarity with this skill levels; accordingly, she is the right one to give a second opinion about her examiner’s qualification; furthermore, a director (as her boss) has more of this particular skills comparing to an ordinary examiner or a supervisor in these group art units (since most of the director and supervisor have climbed up the ranks from the same arts). Upon making decision about a consulted matter, a “YES” or “NO” answer has been given (this may be in oral, or in writing, or using an e-mail; equivalent to a communicating “signal”).
USPTO ‘s method of doing business would be related to “expert qualification” comprising a first expert (examiner) and a second expert having authority to approve the first expert “qualification” (his supervisor). This has widely used/been available in public knowledge; this idea of doing business from **USPTO** would be implemented in cited references by one of ordinary skills in the art, it comprises hierarchical authorities.

“Practice and procedure in Patent and Trademark Office -- Prosecution -- Rules and rules practice (**§ 110.0905**) Patent and Trademark Office, during ex parte examination, is not precluded from relying upon hearsay evidence in making rejections, since applicants are free to investigate any hearsay assertions relied upon by examiner,

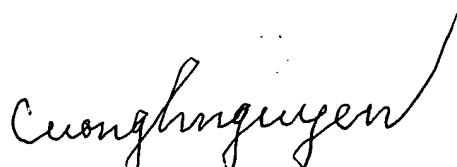
have right to introduce rebuttal evidence, and, if they wish to cross-examine authors of written hearsay assertions, can file civil action pursuant to 35 USC 145.”

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Cuong H. Nguyen
January 31, 2007

Application/Control Number: SN. 09/112,131
Art Unit 3661

An appeal conference was held on January 25, 2007 with:

SPE Thomas Tarcza, Art Unit 3662



Pri. Exmr. Thomas Dixon, Art Unit 3628



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